

Application Serial No. 10/669,238  
Reply to Office Action dated September 26, 2005

### REMARKS/ARGUMENTS

In view of the amendments made to the claims and the following remarks, reconsideration of the application is respectfully requested.

Initially, the Applicant would like to thank the Examiner for the careful review undertaken in connection with presented the first Office Action in this case, particularly the care taken in reviewing the claims for formal reasons. In general, the Applicant has reviewed all of the points set forth by the Examiner on pages 2 and 3 of the Office Action and agrees with the various points raised. To this end, claims 5-7, 9, 12, 17, 18, 25, 28, 29, 33, 34, 37, 38 and 42-45 have been amended to address the concerns raised by the Examiner, without the introduction of any new matter. Of the claims, the Examiner should note that support for the subject matter of claims 18 and 45 can be found in the original specification in paragraph 0028. In addition, it should be noted that the rejection of claim 39 has been addressed by the amendment made to claim 33 from which claim 39 depends. All of the remaining claim changes are seen to be self-evident based on the points raised in the Office Action. In any case, based on the changes made, withdrawal of the rejections based on formal reasons is requested.

Although the Applicant agrees that claim changes were necessary to address various formal matters, the Applicant respectfully disagrees with the Examiner in connection with the application of prior art against the claimed subject matter. In each of the independent claims, a fiber fortified and protein enhanced cooked food product is claimed, with the product having an insoluble dietary fiber ingredient establishing a total insoluble fiber content of 5%-15%, a soluble dietary fiber ingredient establishing a soluble fiber content of 5%-15% and a total insoluble to soluble fiber range from about 1:1 to 1.5:1, and a plant protein ingredient providing a total protein content of about 15% to 30%. Therefore, each of these claims requires an insoluble fiber ingredient, a soluble fiber ingredient and a plant protein ingredient, all in specific ranges and/or proportions. This combination is simply not disclosed or suggested in the prior art. At best, the Examiner has found prior art having individual pieces or parts of the invention, based on

Application Serial No. 10/669,238  
Reply to Office Action dated September 26, 2005

prior art basically presented to the Examiner in the application as background, and improperly combined the references without any suggestion or motivation. For at least this reason, it is respectfully submitted that a proper prima facie case of obviousness has not been established and the rejections should be withdrawn.

More specifically, the Examiner has rejected claims 1-11, 14-25, 28-30, 37, 38 and 43-48 based on Ringe (U.S. Patent 5,024,996) in view of Sander (U.S. Patent No. 6,242,033), while rejecting claims 12, 13, 26, 27, 31-36 and 39-42 in view of this combination in further view of Van Lengerich et al (U.S. Patent No. 6,149,965). The main Ringe patent is owned by the same assignee as the present invention and has been discussed in at least paragraph 0003 of the application as originally filed. Ringe, which was patented over a decade ago, only concerns cereals with soluble and insoluble fiber, with the disclosed embodiments having as much or more of the soluble fiber than the insoluble fiber. The present invention represents an improvement over this known arrangement wherein, at least, a plant protein ingredient is also included and, if anything, the insoluble fiber content would be higher than the soluble fiber content.

The Examiner recognizes the deficiencies in Ringe, at least with respect to the inclusion of any protein ingredient, the timing of adding protein, the amount of protein included, the particle size of the fiber, the puff frying and the addition of a high potency sweetener. The Examiner then cites Sander which is directed to a high protein cereal, holds that it would be obvious to one of ordinary skill in the art to add the high protein ingredients of Sander to Ringe, and then holds all the other features as obvious in view of no specific teaching in the art. The Examiner then includes van Lengerich in the combination to further add inulin to the product.

The test for patentability under 35 U.S.C. §103 is basically whether the differences between the claimed subject matter, considered as the whole, and the prior art would have been obvious at the time the invention was made. Reaching this determination, the skill and content of the prior art, the differences between the prior art and the claimed subject matter and the level of ordinary skill in the art must be

Application Serial No. 10/669,238  
Reply to Office Action dated September 26, 2005

considered, along with the relevant secondary issues. *Graham v. John Deere Co.*, 381 U.S. 1, 148 USPQ 459 (1966).

A proper rejection under 35 U.S.C. §103 cannot be based on hindsight knowledge of the invention under consideration for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd. v. Union Oil Co. of Cal.* 218 USPQ 865, 870 (1983) stated:

*All the pieces of the present invention were known in the art, ... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art (Case citations).*

In the present situation, a cereal product with both insoluble and soluble fiber ingredients is known. In addition, a cereal with a protein ingredient is known. However, this just indicates that pieces of the present invention were known, which is irrelevant. None of the prior art discloses or suggests the combination of the multiple forms of fiber and the plant protein ingredient claimed. Again, the Ringe patent has been around for over a decade and the Sander patent has been around for years as well, still there does not exist any reference to the claimed combination or ingredients, nor any suggestion or motivation to combine. The Examiner appears to hold that the combination is obvious simply because all the pieces of the invention are known. As set forth above, the courts have already ruled against taking such a position.

Further, the CAFC in *In re Gordon*, 221, USPQ 1125, 1127 (1984) stated:

*The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)*

Application Serial No. 10/669,238  
Reply to Office Action dated September 26, 2005

Furthermore, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 USPQ 763, 771 (1984) quoted:

*A patentable invention... may result even if the inventor has in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis theirs.)*

Again, the combination of ingredients must be suggested in the art, not simply held as obvious just because all the ingredients can be individually found in various references. Along these lines, references must be evaluated by ascertaining the facts fairly disclosed therein as a whole. It is impermissible to first ascertain factually what [applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant's invention from such prior art. *In re Shuman and Meinhardt*, 150 USPQ 54 (CCPA 1966). In the present situation, the invention addresses the problems with dry, short lived, highly frangible features of high insoluble fiber products, gummy or slimy consumption features of high soluble fiber products, and decreased starchy constituents in connection with at least high protein products in arriving at a high insoluble fiber, high soluble fiber and high protein ingredient cooked dough product that has superior organoleptic attributes or qualities as discussed in the specification. It is respectfully improper to combine the prior art, which does not equally address these problems or arrive at the inventive solution, by simply piecing together ingredients from various references. As a whole, Ringe is not concerned with a high protein product. As a whole, Sander is not concerned with a high multi-fiber product. Simply stated, neither Ringe nor Sander suggest making a combination high multi-fiber and high protein cooked dough product and it is not permissible for the suggestion for the combination to simply come from the Examiner for a proper prima facie case of obviousness. That is, it is clear that it is the PTO that has to establish a prima facie case of obviousness and "obvious can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentives supporting the combination." *ACS*

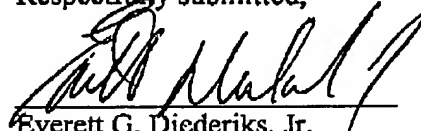
Application Serial No. 10/669,238  
Reply to Office Action dated September 26, 2005

*Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and *Ray Geiger*, 815 F.2d 686 (Fed. Cir. 1987).

In a similar manner, van Lengerich et al is not concerned with a high insoluble fiber, high soluble fiber and high plant protein product such that the mere fact that van Lengerich et al teaches to make a cereal dough with inulin does not detract from the inventiveness of the combination set forth in this application.

Based on the above, it is respectfully requested that both the formal and prior art rejections be withdrawn, the claims allowed and the application passed to issue. If the Examiner should have any additional concerns regarding the allowance of the application that can be readily addressed, she is cordially invited to contact the undersigned at the number provided below in order to further expedite the prosecution.

Respectfully submitted,



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